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UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,671	12/24/2003	Kia Silverbrook	NPB008US	7891

24011 7590 07/10/2007		

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EXAMINER
LE, KHANH H

ART UNIT	PAPER NUMBER
3622	

MAIL DATE	DELIVERY MODE
07/10/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action *Before the Filing of an Appeal Brief*	Application No. 10/743,671	Applicant(s) SILVERBROOK ET AL.	
	Examiner Khanh H. Le	Art Unit 3622	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED <u>26 April 2007</u> FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

   a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.

   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

     Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

<u>NOTICE OF APPEAL</u>

2. ☐ The Notice of Appeal was filed on _____ . A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

<u>AMENDMENTS</u>

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will <u>not</u> be entered because

   (a)☐ They raise new issues that would require further consideration and/or search (see NOTE below);

   (b)☐ They raise the issue of new matter (see NOTE below);

   (c)☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d)☐ They present additional claims without canceling a corresponding number of finally rejected claims.

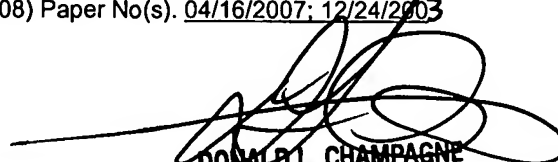   NOTE: _____ . (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____ .

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the ~~proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.~~

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____ .

   Claim(s) objected to: _____ .

   Claim(s) rejected: <u>*1-4*</u>.

   Claim(s) withdrawn from consideration: <u>*8-11*</u>.

<u>AFFIDAVIT OR OTHER EVIDENCE</u>

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will <u>not</u> be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will <u>not</u> be entered because the affidavit or other evidence failed to overcome <u>all</u> rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

<u>REQUEST FOR RECONSIDERATION/OTHER</u>

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
   <u>See Continuation Sheet.</u>

12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). <u>04/16/2007; 12/24/2003</u>

13. ☒ Other: <u>Note the attached PTO-892 form</u> .

DONALD L. CHAMPAGNE
PRIMARY EXAMINER

Continuation of 11. does NOT place the application in condition for allowance because:

1.   Applicant's arguments have been fully considered but they are not persuasive.

2.   Applicants argue (Response, page 5, paragraphs 4-5) that Dymetman does not teaches" (e) generating, in a printer, first dot data for coded data using said page identity, said coded data identifying said page identity and a plurality of positions on said publication" because "Presumably, Dymetman conceived that all the coded data comprising page-id and pointer-loc information is predetermined before printing. This predetermined coded data is then sent to a printer for printing, thereby generating one of Dymetman's coded 'blanks'."

The issue turns on the interpretation of the claim term "generating".

3.   Note on the interpretation of claim terms. Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe an invention, but must do so with reasonable clarity, deliberateness, and precision" (MPEP § 2111.01.IV). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ... ".

4.   The instant application contains no such clear definition for the term "generating". In the instant case, the examiner is required to give the term " generating " its broadest reasonable interpretation, which the examiner judges to be "to produce something according to an algorithm or program or set of rules...(generate. (n.d.). The Free On-line Dictionary of Computing. Retrieved May 30, 2007, from Dictionary.com website: http:// dictionary.reference.com/browse/generate).
A printer has a printing program. Thus even if the DYMETMAN coded data is predetermined then sent to the printer, as argued (but not conceded as true), once received in the printer and printed by the printer, the coded data is interpreted as at least being re-generated by the printer and therefore "generated in the printer" as claimed.

5,   Applicants next argue "By contrast, the present invention requires the coded data to be generated in the printer using the page identity. Hence, the coded data is not predetermined and sent to the printer for printing. Rather, the coded data is generated in the printer from the page identity."
However "not predetermined" is not claimed. Further, even if predetermined and sent to the printer, the DYMETMAN coded data is at least regenerated (thus "generated") in the printer; and since, even if predetermined, the coded data uses the page identity, the regeneration in the printer at least indirectly uses the page identity, hence reads on "uses the page identity " since the claim language does not forbid indirect use.
6.   Applicants next argue "Hence, the printer generates coded data identifying a plurality of positions; this information is not predetermined and received by the printer".
However, as to the plurality of positions, again "not predetermined" is not claimed and indirect use (following the logic above) is not forbidden by claim language. It is also noted "the printer generates coded data identifying a plurality of positions" is not claimed. The claim language is "generating in a printer first dot data for coded data" (underline emphasis added). Dymetman's printer definitely generates first dot data representing coded data (whether predetermined or not) which uses page identity and plurality of locations. Thus Dymetman meets the claim limitation.

7.   Applicants next argue Dymetman does not teach:
(d) associating said page identity with said description of said input element (wherein the input element, as defined in step (c), includes a description of a zone of the input element on the page)

Applicants agree that DYMETMAN discloses the page identity has to be associated with a description of each input element on a page but argues Dymetman makes this association after all the printing steps have been performed in contrast to the present invention.

Even if Dymetman makes this association after all the printing steps, as argued (this is not conceded as necessarily true), the methods steps are not claimed as being performed in the particular order as listed by the letters a), b), c). Thus step d) of associating does not necessarily have to be interpreted as coming before the printing steps g), f).

Altiris Inc. v. Symantec Corp., 65 USPQ2d 1865 (CA FC 2003) held that
"Test for determining whether steps of method claim that do not specifically recite order must nevertheless be performed in order in which they are written requires examination of claim language to ascertain whether, as matter of logic or grammar, steps must be performed in order written, and if not, then remainder of specification is examined to determine whether it directly or implicitly requires narrow construction" " and

"Steps recited in method claim for intercepting and controlling boot process of computer need not be performed in order in which they are written, since claim language does not indicate, either grammatically or logically, that "setting" step must occur in particular order compared to other steps, and since written description discusses single embodiment in which "setting" step occurs after "testing" step and before "booting normally" step, but there is no statement that this order is important, no disclaimer of any other order of steps, and no prosecution history indicating surrender of any other order."

Here the claim language does not indicate, either grammatically or logically, that "associating" step must occur in particular order compared to other steps.

Since, "printing on demand" is not claimed (though argued), logically this order is not important. (The proof of this is that DYMETMAN -- which Applicants argue does not show printing on demand- can be interpreted as reading on these limitations).

The Examiner cannot find in the instant written description and that of the parent (US App. Nb. 09/575193, now US Patent 7068382) any discussion that the "associating " step having to occur before a "printing" step. There also is no statement that this order is important, no disclaimer of any other order of steps, and no prosecution history indicating surrender of any other order.

Applicants' arguments now are not sufficient to be taken as a disclaimer of any other order of steps, and there is no prosecution history indicating surrender of any other order.

7.   Applicants next argue "even if the Dymetman were to adopt the teaching of Ur, there is nothing in Ur teaching the skilled person to make an association between a zone of an input element and a page identity prior to printing." Ur does not need to teach the association since Dymetman already teaches it and "prior to printing" is not required by the claim language as discussed above.